

REMARKS

Claims 18-37 are pending. By this Amendment, Claim 20 is amended, thereby leaving Claims 18-19 and 21-37 unchanged.

Double Patenting Rejection

Claims 18-37 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-26 of U.S. Patent No. 6,108,916.

Applicants hereby submit a Terminal Disclaimer with this response to overcome the double patenting rejection of Claims 18-37 of the present application.

35 U.S.C. § 103(a) Rejections

Claims 18-19, 24-26, 29-30, 32-33 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,044,559 ("Holst"). Reconsideration of the rejections is respectfully requested.

Independent Claim 18 recites (italics added for emphasis):

A power tool comprising:
a housing;
a motor supported by the housing and operable to drive a tool element relative to a first axis; and
a handle *supported by the housing for movement relative to the housing* about a second axis, the second axis being one of generally parallel to and the same as the first axis, the first axis and the second axis being fixed relative to the housing, the handle having a first position relative to the housing and a second position relative to the housing, the power tool being operable with the handle in the first position and in the second position.

Holst discloses a power drill 14 and a plurality of circular cutting blade attachments 10a, 10b, 10c separate from the power drill 14. Components of the attachments 10a, 10b, 10c are self-supported within the attachments and completely independent of the power drill 14. The power drill 14 includes a housing, a drill handle 52 supported by the housing, and a standard drill chuck 36. The attachments 10a, 10b, 10c include shafts 20, 30, 31, cutting blades 16, 28, 29, and handles 12a, 12b, 12c supported by the shafts 20, 30, 31. In some embodiments, the handle includes a pivot 46 for pivoting a lower portion of the handle relative to an upper portion of the

handle and, simultaneously, a bushing 38 of the upper portion is pivotal about the shafts to move the upper portion, lower portion and the pivot relative to the attachments and the power drill 14.

Holst does not teach or suggest, among other things, a handle supported by a housing of a power tool for movement relative to the housing. Rather, Holst discloses a circular cutting attachment 10 that is independent of the power drill 14 and that includes a handle 12 supported by the attachment 10, not supported by the housing of the power drill. For these and other reasons, Holst does not teach or suggest the subject matter of independent Claim 18.

The Examiner does not provide any other reference to cure the deficiencies of Holst. To establish a *prima facie* case of obviousness, the prior art references, when combined, must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§ 706.02(j), 2143.03. Since Holst does not teach or suggest the subject matter of independent Claim 18 and the Examiner does not provided another reference to cure the deficiencies of Holst, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 18 based upon the prior art as required by 35 U.S.C. § 103. Accordingly, Claim 18 is allowable. Claims 19 and 24 depend from independent Claim 18 and are allowable for the same and other reasons.

Independent Claim 25 recites (italics added for emphasis):

A power tool comprising:
a housing;
a motor supported by the housing and operable to rotatably drive a saw blade about a first axis; and
a handle supported by the housing for movement relative to the housing,
the handle being graspable by an operator to provide for movement of the power tool relative to a work piece, the handle being pivotal about the first axis.

Holst does not teach or suggest, among other things, a handle supported by a housing of a power tool for movement relative to the housing. Rather, Holst discloses a circular cutting attachment 10 that is independent of the power drill 14 and that includes a handle 12 supported by the attachment 10, not supported by the housing of the power drill 14. For these and other reasons, Holst does not teach or suggest the subject matter of independent Claim 25.

Again, the Examiner does not provide any other reference to cure the deficiencies of Holst. As indicated above, to establish a *prima facie* case of obviousness, the prior art references, when combined, must teach or suggest all of the claim limitations. In re Royka, 490

F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§ 706.02(j), 2143.03. Since Holst does not teach or suggest the subject matter of independent Claim 25 and the Examiner does not provided another reference to cure the deficiencies of Holst, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 25 based upon the prior art as required by 35 U.S.C. § 103. Accordingly, Claim 25 is allowable. Claims 26-31 depend from independent Claim 25 and are allowable for the same and other reasons.

Independent Claim 32 recites (italics added for emphasis):

A power tool comprising:
a housing;
a motor supported by the housing and operable to rotatably drive a tool element about a first axis fixed relative to the housing; and
a handle supported by the housing for movement relative to the housing,
the handle being pivotal about the first axis, the handle having a first position relative to the housing and a second position relative to the housing, the power tool being operable with the handle in the first position and in the second position.

Holst does not teach or suggest, among other things, a handle supported by a housing of a power tool for movement relative to the housing. Rather, Holst discloses a circular cutting attachment 10 independent of the power drill 14 and includes a handle 12 supported by the attachment 10, not supported by the housing of the power drill 14. For these and other reasons, Holst does not teach or suggest the subject matter of independent Claim 32.

Again, the Examiner does not provide any other reference to cure the deficiencies of Holst. As indicated above, to establish a *prima facie* case of obviousness, the prior art references, when combined, must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§ 706.02(j), 2143.03. Since Holst does not teach or suggest the subject matter of independent Claim 32 and the Examiner does not provided another reference to cure the deficiencies of Holst, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 32 based upon the prior art as required by 35 U.S.C. § 103. Accordingly, Claim 32 is allowable. Claims 33-37 depend from independent Claim 32 and are allowable for the same and other reasons.

Allowable Subject Matter

Claims 20-23, 27-28, 31 and 34-36 were rejected only under obviousness-type double patenting and were not rejected in view of prior art. Therefore, Applicants can only assume that the Examiner believes these claims are allowable over the prior art. Applicants have amended Claim 20 into independent form including all the limitations of the base claim. Accordingly, independent Claim 20 is allowable. Claims 21-23 depend from independent Claim 20 and are allowable for the same and other reasons.

CONCLUSION

In view of the foregoing, entry of the present Amendment and allowance of Claims 18-37 is respectfully requested.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Paul M. McGinley', with a long horizontal flourish extending to the right.

Paul M. McGinley
Reg. No. 55,443

Docket No. 066042-9216-03
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(414) 271-6560